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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,268	08/28/2000	Michael S. Chartier	042390.P219	6762

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EXAMINER

SCHNEIDER, JOSHUA D

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 10/02/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/649,268

Applicant(s)

CHARTIER, MICHAEL S.

Examiner

Joshua D Schneider

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/25/2003 have been fully considered but they are not persuasive. With regards to the 35 U.S.C. 112, second paragraph rejection, it is recognized that there is basis in the specification for the use of the phrase "transmit a transmitted message." However, it does not change the fact that the language is non-idiomatic and therefore indefinite, as the word does not have a clear definition. It would be impossible for one to transmit a message that has already been transmitted. Applicant is advised to change the language to more clearly state, "transmit a message to be transmitted" as the specification teaches.
2. With regards to the arguments that U.S. Patent 5,748,084 to Isikoff does not teach a first processor and a second processor, Applicant is directed to Figures 3 and 4. Isikoff teaches an activated modem processor which receives and stores data (Fig. 3, column 3, lines 62-65, and column 5, lines 54-49) when a first processor of the host computer is deactivated (Fig. 4, column 9, lines 15-27).
3. With regards to the arguments that any activity taught by Isikoff involving the data modem also involves the microprocessor (30), applicant again pointed to Figs. 3 and 4. It is shown in these figures that there are in fact two processors in the system, one of which can be inactive while the second, resident in the modem, remains active for the sending and receiving of communications. Microprocessor 30 remains active, while the host processor is inactive.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. See 37 CFR 1.72(a) and MPEP §

606. The title of the invention should be brief but technically accurate and descriptive; preferably from two to seven words may not contain more than 500 characters.

The following title is suggested: Modem for operation independent of a main processor.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner is unclear what the phrase "transmit a transmitted message" means.

7. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "transmit a transmitted message" in claim 5 is used by the claim to mean, "transmit a message to be transmitted", while the accepted meaning is "transmit a message that has been transmitted." The term is indefinite because the specification does not clearly redefine the term.

8. All further rejections are made with regards to the specification as best understood in light of the previous objections and rejections.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2182

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 8-9, 13-14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,748,084 to Isikoff. With regards to claim 8, Isikoff teaches an activated modem processor which receives and stores data (Fig. 3, column 3, lines 62-65, and column 5, lines 54-49) when a first processor of the host computer is deactivated (Fig. 4, column 9, lines 15-27).

11. With regards to claim 9, Isikoff teaches the beacon unit controls the power supply (column 4, lines 15-20, column 2, lines 12-14, and column 9, lines 15-17).

12. With regards to claims 13 and 14, Isikoff teaches the processor stores in memory user file names and types which are to be transferred (column 6, lines 5-11).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-7, 10-12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,748,084 to Isikoff. With regards to claim 1, the Isikoff reference teaches a beacon unit (Fig. 3) comprising a modem adapted to receive communication, a processor coupled to the modem (Fig. 4), and a memory coupled to the modem when the processor is inactive (column 3, line 62, through column 4, line 2, and column 9, lines 15-27). While Isikoff does not explicitly teach non-volatile memory, the beacon is battery backed and retains power even when power is removed from the main computer and processor (Figs. 3 and 4). It would have been obvious to

Art Unit: 2182

one of ordinary skill in the art at the time of invention that the beacon memory of Isikoff is battery backed and is therefore nonvolatile.

15. With regards to claim 2, Isikoff teaches a hard drive that is coupled to the processor (column 4, lines 15-20).

16. With regards to claim 3, the beacon processor (Fig. 3, element 30) of Isikoff operates as a processor for the modem and independently of the main processor (column 9, lines 15-27).

17. With regards to claim 4, Isikoff teaches that the beacon communication handling section logs unimportant requests, when the main processor is inactive, to be handled at another time to save power (column 9, lines 15-32).

18. With regards to claims 5 and 6, Isikoff teaches the beacon transmitting messages from memory when the main computer is powered down (column 6, lines 2-16, and column 9, lines 33-52).

19. With regards to claim 7, the memory stores user profile information regarding what types of files are to be transferred and stored in the memory (column 6, lines 2-16).

20. With regards to claim 10, While Isikoff does not explicitly teach non-volatile memory; the beacon is battery backed and retains power even when power is removed from the main computer and processor (Figs. 3 and 4). It would have been obvious to one of ordinary skill in the art at the time of invention that the beacon memory of Isikoff is at least battery backed and is therefore nonvolatile.

21. With regards to claim 11, Isikoff teaches that the beacon processor stores data into the memory (column 9, lines 15-32). Flash memory is well known in the art and it would have been

Art Unit: 2182

obvious to one of ordinary skill in the art at the time of invention that the beacon memory could be a flash memory array.

22. With regards to column 12, Isikoff teaches the host computer being passed data to be processed (column 5, lines 47-51). It would have been obvious to one of ordinary skill in the art at the time of invention that the host processor would be involved in this access.

23. With regards to claims 15 and 16, Isikoff teaches the beacon processor stores user profile information in the memory regarding what types of files are to be transferred and stored in the memory (column 6, lines 2-16). It would have been obvious to one of ordinary skill in the art at the time of invention that either processor could have been used to store user profile identifying information into the memory.

24. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,418,533 to Angelo et al. With regards to claim 18, Angelo et al. reference teaches a computer having a RF receiver unit capable of receiving communication activating a feature (column 3, lines 8-13), even when the computer is not on. Angelo et al. teaches the computer may be portable (column 3, lines 32-37). While Angelo et al. does not teach a modem, it would have been obvious to one of ordinary skill in the art at the time of invention that the RF receiver device could be a modem.

25. With regards to claim 19, Angelo et al. teaches the signal is saved by saving a bit key in non-volatile RAM of the computer (column 3, lines 32-37).

26. With regards to claim 20, Angelo et al. teaches a RF receiver unit the computer (column 3, lines 8-13), which inherently receives communications wirelessly.

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Schneider whose telephone number is (703) 305-7991. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JDS


JEFFREY GAFFIN
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